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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,419	06/18/2001	Takasi Oonuki	14714	9624
23389 7590 01/31/2007 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			EXAMINER NGUYEN, MINH CHAU	
			ART UNIT	PAPER NUMBER
			2145	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/883,419

Applicant(s)

OONUKI, TAKASI

Examiner

MINH-CHAU N. NGUYEN

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

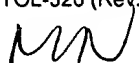
Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |



DETAILED ACTION

This action is responsive to the amendment of the applicant filed on 11/13/06. Claims 1 and 5 are presented for further examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaganti et al. (Chaganti) (US 6,845,448 B1), and further in view of Katsikas (US 6868498 B1).
2. Regarding claim 1, Chaganti teaches a personal information providing system for providing personal information regarding a user through the Internet, said system comprising:

a personal information storer (i.e. the database 108 coupled to the server computer 100 in figure 1) configured to store an identifying information (i.e. an authorization key, password, identification, etc.) for a recipient (i.e. a requester 105 in figure 1) of an electronic mail (i.e. "The requester 105 preferably establishes ... Preferably, an information object is released to the requester only if the requester's security classification is at least that of the information object requested" (Col. 11, L. 9-47). From this paragraph, the storer (i.e. database 108) stores the identifying

information of a recipient (i.e. the requester) of an electronic mail which is *sent by the recipient*) (Col. 9, L. 49-Col. 10, L. 36; and Col. 11, L. 9-47); and

a provider (i.e. the server computer 100) for authenticating a requester (i.e. the requester 105 in figure 1) using said identifying information (i.e. an authorization key, password, identification, etc.) and providing the personal information regarding the user (i.e. the user 103 in figure 1) to said requester (i.e. “Preferably, after authenticating the requester 105 and if the requester is determined to be a genuine entity, a security level is assigned to the requester’s request... Preferably, an information object is released to the requester only if the requester’s security classification is at least that of the information object requested” (Col. 11, L. 38-47). That means the provider (i.e. the server), first of all, authenticates the requester by using his/her identifying information. Then, the server provides the user 105’s personal information to the requester only if the requester is authenticated) (Col. 2, L. 18-43; and Col. 5, L. 29-42; and Col. 6, L. 17-45; and Col. 9, L. 49-Col. 10, L. 36; and Col. 11, L. 9-47).

Chaganti fails to teach the storer (i.e. the database 108) stores the identifying information for the recipient of the electronic mail *sent by the user*. However, Katsikas, in the same field of endeavor having closely related objectivity, teaches a personal information storer (i.e. an Authorized Sender List (ASL) 203 or Database in the email server 104) stores identifying information (i.e. email address) for a recipient of an electronic mail sent by the user (i.e. “an Authorized Sender List (ASL) Manager captures recipient email addresses from email sent by the user, as shown at block

105". This phase teaches the ASL 203 or database in the server 104 stores the recipient's identifying information of email which is sent by the user/sender) (figure 1B, 2, 3A&B; and Col. 4, L. 37-55).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Katsikas's teachings of the identifying information for a recipient of an electronic mail sent by the user, in the teachings of Chaganti in online repository for personal information, for the purpose of protecting the personal information of users by controlling the access of unknown requesters/recipients to the user's personal information.

3. Claim 5 is corresponding method claim of system claim 1. Therefore, it is rejected under the same rationale.

Response to Arguments

4. Applicant's arguments filed 11/13/06 have been fully considered but they are not persuasive.

(A) The Examiner provides no actual evidence which would motive or suggest to one skilled in the art to add the ASL of Katsikas to the invention of Chaganti.

As to point (A), Chaganti teaches a personal information storer [i.e. the database 108 coupled to the server computer 100 in figure 1] configured to store an identifying information [i.e. an authorization key, password, identification, etc.] for a

recipient [i.e. a requester 105 in figure 1] of an electronic mail [i.e. “The requester 105 preferably establishes ... Preferably, an information object is released to the requester only if the requester’s security classification is at least that of the information object requested” (Col. 11, L. 9-47). From this paragraph, the storer (i.e. database 108) stores the identifying information of a recipient (i.e. the requester) of an electronic mail which is *sent by the recipient*] (Col. 9, L. 49-Col. 10, L. 36; and Col. 11, L. 9-47); and a provider [i.e. the server computer 100] for authenticating a requester [i.e. the requester 105 in figure 1] using said identifying information [i.e. an authorization key, password, identification, etc.] and providing the personal information regarding the user [i.e. the user 103 in figure 1] to said requester [i.e. “Preferably, after authenticating the requester 105 and if the requester is determined to be a genuine entity, a security level is assigned to the requester’s request... Preferably, an information object is released to the requester only if the requester’s security classification is at least that of the information object requested” (Col. 11, L. 38-47). That means the provider (i.e. the server), first of all, authenticates the requester by using his/her identifying information. Then, the server provides the user 105’s personal information to the requester only if the requester is authenticated] (Col. 2, L. 18-43; and Col. 5, L. 29-42; and Col. 6, L. 17-45; and Col. 9, L. 49-Col. 10, L. 36; and Col. 11, L. 9-47).

Chaganti fails to teach the storer [i.e. the database 108] stores the identifying information for the recipient of the electronic mail *sent by the user*. However, Katsikas, in the same field of endeavor having closely related objectivity, teaches a

personal information storer [i.e. an Authorized Sender List (ASL) 203 or Database in the email server 104] stores identifying information [i.e. email address] for a recipient of an electronic mail sent by the user [i.e. "an Authorized Sender List (ASL) Manager captures recipient email addresses from email sent by the user, as shown at block 105". This phase teaches the ASL 203 or database in the server 104 stores the recipient's identifying information of email which is sent by the user/sender] (figure 1B, 2, 3A&B; and Col. 4, L. 37-55).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Katsikas's teachings of the identifying information for a recipient of an electronic mail sent by the user, in the teachings of Chaganti in online repository for personal information, for the purpose of protecting the personal information of users by controlling the access of unknown requesters/recipients to the user's personal information.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is to help provide a user's personal information to other users (i.e. requesters/recipients)

whom are identified.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-CHAU N. NGUYEN whose telephone number is (571)272-4242. The examiner can normally be reached on Monday-Friday from 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JASON D. CARDONE can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2145

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Minh-Chau Nguyen

Art Unit: 2145



JASON CARDONE
SUPERVISORY PATENT EXAMINER